



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,896	12/17/2001	Andrew W. Blackett	6270/72	8784

757 7590 04/05/2004

GENERAL NUMBER 00757  
BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60611

EXAMINER

RODRIGUEZ, PAUL L

ART UNIT	PAPER NUMBER
----------	--------------

2125

DATE MAILED: 04/05/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/024,896

Applicant(s)

BLACKETT ET AL.

Examiner

Paul L Rodriguez

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,5-31 and 34-48 is/are allowed.
- 6) ☒ Claim(s) 4 and 33 is/are rejected.
- 7) ☒ Claim(s) 3 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The preliminary amendment filed 3/12/04 has been received and considered. Claims 1-48 are presented for examination.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/12/04 has been entered.

***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 3/12/04 has been received. The submission is in compliance with the provisions of 37 CFR 1.97 and the examiner is considering the information disclosure statement.
4. The information disclosure statement filed 3/12/04 contains a large number of references submitted for consideration that appear to be cumulative and are consistent with the progress in the art. In view of the number of references in this application, the Applicant is requested to identify any specific references, features, sections or figures in the references cited which are believed to have particular significance in the prosecution of this application or which are

Art Unit: 2125

considered material to the patentability of the pending claims, for further consideration by the Examiner.

5. The information disclosure statements filed 3/12/04 has been considered, however applicant will find a number of references lined through. Those references have been lined through for the following reasons

- \* The reference was submitted on a previous IDS in the case.

- \*\* The reference was previously cited by the Examiner on a PTO-892.

- \*\*\* The reference listed on the IDS was previously listed on the IDS and is redundant.

The remaining references were treated as addressed in the below paragraph.

6. Regarding the information disclosure statements filed 3/12/04. The examiner has reviewed and considered all the cited references and has determined that most references appear to be commensurate with the state of the art of power distribution, energy meters and network communications and are not necessarily specific to determining the patentability of the claimed invention. Examiner has initialed the references that are considered pertinent to the instant application and has lined through the remaining references that are not considered to be material to the patentability of the claimed invention. If the applicant feels that one of the lined through references is material to the patentability of the application and should be cited on any possible printed patent document (unless it was previously cited by Applicant or Examiner), it is requested that that document be pointed out in the response to this office action.

***Claim Objections***

7. Claims 3, 32 are objected to because of the following informalities: Contains the acronym “RTU” which is not defined in the claim and could render the claim indefinite. The specification defines the acronym as Remote Terminal Unit. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 4 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 4 and 33 contain the trademark/trade name ION. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a particular communications protocol and, accordingly, the identification/description is indefinite.

*Allowable Subject Matter*

11. Claims 1, 2, 5-31 and 34-48 are allowed.
12. Claims 3 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is an examiner's statement of reasons for allowance:

While Hart et al (U.S. Pat 6,005,759) discloses an energy meter for managing the distribution of electrical energy, the energy meter comprising at least one sensor coupled with an electric circuit to sense at least one parameter and to generate at least one analog signal indicative thereof, a housing, at least one analog to digital converter, a communications port to facilitate communications between the energy meter and a slave device, a processor coupled with the analog to digital converter and the communications port, the processor operative to perform a power management function and a server module coupled with said processor and operative to facilitate communication to a client application over a digital network to manage the distribution of electrical energy, Carpenter et al (U.S. Pat 6,553,418) teaches a data network for the sharing of meter readings over a network and Kelly et al (U.S. Pat 6,088,659) and Jenny et al (U.S. Pat 5,897,607) teach meter readings over the Internet, none of these reference taken either alone or in combination with the prior art of record disclose an energy meter, including:

“at least one sensor coupled with an electric circuit and operative to sense at least one electrical parameter in said electric circuit and generate at least one analog signal indicative

Art Unit: 2125

thereof, a meter housing, at least one analog to digital converter located in said meter housing and coupled with said at least one sensor and operative receive said at least one analog signal to convert said at least one analog signal to at least one first digital signal”,

in combination with the remaining elements and features of the claimed invention. It is for these reasons, along with the reasons argued by applicant in the preliminary amendment filed 3/12/04, that the applicant’s invention defines over the prior art of record.

14. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

#### ***Response to Arguments***

15. Applicant’s arguments see pages 10-11, filed 3/12/04, with respect to claims 1-48 have been fully considered and are persuasive. The rejection of claims 1-48 has been withdrawn.

16. Applicant's additional arguments filed 3/12/04 have been fully considered but they are not persuasive. Applicant argues that Trademarks are not prohibited by 35 U.S.C. 112. Examiner found clear direction in the MPEP that indicates the use of Trademarks, as claim limitations should be avoided. See the below passage.

2173.05(u) Trademarks or Trade Names in a Claim

The presence of a trademark or trade name in a claim is not, per se, improper under 35 U.S.C. 112, second paragraph, but the claim should be carefully analyzed to determine

Art Unit: 2125

how the mark or name is used in the claim. It is important to recognize that a trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. See definitions of trademark and trade name in MPEP § 608.01(v). A list of some trademarks is found in Appendix I.

If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

If a trademark or trade name appears in a claim and is not intended as a limitation in the claim, the question of why it is in the claim should be addressed. Does its presence in the claim cause confusion as to the scope of the claim? If so, the claim should be rejected under 35 U.S.C. 112, second paragraph.

Based upon the above and other passages in the MPEP and with the use of established form paragraphs, claims 4 and 33 are rejected for the use of Trademarks as a claim limitation.

Also, claim objections remain for the claims that did not define the acronyms used. If the acronyms used in claims 3 and 32 are Trade names (Modbus RTU), applicant should refer to the above rejection of claims 4 and 33 for guidance.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Forth et al (U.S. Pat 6,671,635) – teaches a meter with an A/D converter in the meter housing and network communications capabilities.



Art Unit: 2125

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399.

The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul L Rodriguez  
Examiner  
Art Unit 2125

PLR  
4/2/04